REMARKS

Claims 1-7, 10-22 and 25-35 remain in the application for further prosecution.

The Applicants thank the Examiner for allowance of claims 26-35.

Claim Rejections Over Weiss In View Of Ohno In View Of Walker - 35 U.S.C. § 103(a)

Claims 1-7, 10-22 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,165,071 to Weiss ("Weiss") in view of U.S. Patent No. 5,609,525 to Ohno et al. ("Ohno") and in further view of U.S. Patent No. 6,364,765 to Walker et al. ("Walker"). (Office Action, page 2.)

The Applicants respectfully request the Examiner to reconsider the rejections of these claims because, within the proposed combination of references, the required modification of Weiss is improper.

Pursuant To § 2143 Of The MPEP, The Rejections Are Improper

The mere fact that references can be combined or can be modified is not the standard for a determination of obviousness. Much more is needed. The entire teachings of the prior art references must be considered. Here, when the entire teachings of the references are considered, it is clear that the rejections are improper.

The Applicants agree with the Examiner that Weiss and Ohno "both fail to disclose storing the status of the paused or stopped game at a central database linked to and remote from the gaming machine and retrieving the status of the paused game form the central database." Final Office Action, page 3. The Applicants strongly disagree, however, that "it would have been obvious to one of skill the art at the time the invention was made to modify the Weiss in view of Ohno type system in order to store player gaming status in the central storage which

would facilitate data transmission and save/protect gaming status data in the event a player loses his player tracking card." Final Office Action, page 3. To establish a *prima facie* case of obviousness, the proposed modification of the prior art cannot change the principle of operation of the prior art invention being modified. MPEP § 2143.01. In short, if the suggested combination of references requires "a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which [the primary reference's] construction was designed to operate," then the teachings of the references are not sufficient to render the claims obvious. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

The rejection proposed by the final Office Action requires modifying Weiss to use a gaming machine network having a central server. Yet, Weiss's invention was specifically constructed and designed to record all data on a player memory card so as to avoid the need for such a gaming machine network. In fact, Weiss discusses gaming machine networks, just like Walker's gaming machine network, in his Background section. Column 1, lines 44-51. Weiss then concludes why these gaming machine networks should be avoided.

> Many players, however, are reluctant to participate in what they may view as a form of surveillance and therefore player tracking instrumentalities in which the player is identified has been met with only moderate acceptance by players.

Column 1, lines 52-56. Weiss then goes on to tout the advantages of his invention -- a player memory card that records all the pertinent data -- which will be widely accepted by all types of players. Without question, the final Office Action proposes "a substantial reconstruction and redesign" of Weiss's elements to arrive at the present invention. While Weiss's fundamental teaching (and his claimed invention!) is, in essence, "let's gather the pertinent data and store it **ONLY** on a player memory card to avoid the need for storing the data on a gaming machine

network," the final Office Action attempts to distort Weiss's very specific teaching into "let's gather the pertinent data and store it on a gaming machine network," thereby changing Weiss's principle of operation.

The Applicants respectfully suggest that a hindsight reconstruction of the Applicants' invention may have occurred because the skilled artisan, after reading Weiss and the other references, would never conclude "let's gather Weiss's game-related data and store it on a gaming machine network." This is especially true when considering that Weiss specifically mentions the problems of gaming machine networks in his Background section, problems that are solved by Weiss's invention. Consequently, the Applicants maintain that the proposed modification of Weiss fundamentally changes the principle of operation of Weiss and, consequently, the proposed combination of references cannot be used to render the claims obvious.

The Applicants note the "Response to Arguments" section in the final Office Action at pages 5-6, and provide the following comments. First, it is stated that "[o]ne cannot show non-obviousness by attacking references individually where as here the rejection are based on a combination of references." While that surely is a statement quoted from *In re Keller*, 642 F.2d 413 (CCPA 1981) as noted Section 2145(IV) of the MPEP, it is not applicable here. The Applicants' position, as set forth above, attacks the proposed modification of Weiss that discards Weiss's fundamental "anti-network" teaching and supplants it with Walker's network. If a combination, as here, requires a modification to the primary reference and the Patent Office's proposed modification distorts the primary reference to a point that the modification either (i) renders the primary reference unsatisfactory for its intended purpose or (ii) changes the principle

of operation of the modified primary reference, then the rejection should be attacked by focusing on the improper modification of the primary reference. See MPEP § 2143.01.

Second, the "Response to Arguments" section discusses another of the Applicants' positions regarding why the present rejections are improper (*i.e.*, the "teaching away" position) but does not mention or address this improper-modification position, which was set forth at pages 12-14 of the Reply to Office Action dated September 22, 2003. The Applicants still believe that their "teaching away" position is proper and they do not agree with the Examiner's view, but invite the Examiner to address this improper-modification position, to the extent the Examiner maintains the rejection.

And, third, the Examiner's arguments on page 6 of the final Office Action regarding the anonymity or player identification features in Walker do not, in any way, negate the fundamental position that Weiss has been improperly modified to include a Walker-like gaming machine network in which Weiss's game data is stored centrally. See MPEP § 2143.01.

A Prima Facie Case Of Obviousness Also Cannot Be Established Because The References Fail To Disclose Storing The Status Of A "Paused" Wagering Game

Walker clearly does not teach the concept of storing a "paused" wagering game. Further, Ohno fails to teach anything whatsoever about "wagering games." Regarding Weiss, the Examiner states that "Weiss further discloses that when playing, should the player elect to quit or pause, the memory card is updated and then returned to the player via slit 6." Office Action, pages 2-3 (emphasis added). The passage in Weiss to which the Office Action refers, however, does not include the words "or pause": "[s]hould the player elect to quit, the memory card 20 is updated and then returned to the player via the slit 6." Column 5, lines 13-15 (emphasis added).

As described below, this "updating" in Weiss appears to be describing some type of "rewards" program where a player achieves "milestones" for his or her protracted wagering.

Weiss explicitly contemplates that a player can either "initiate" or "discontinue" play. But, nowhere does Weiss disclose that a player can pause the wagering game and continue the wagering game at the paused point at a later time. In fact, in a number of other places, Weiss discloses that a player can either initiate or cease play: *see* "the instant invention allows the player the opportunity to initiate play or discontinue play at his own whim," column 1, lines 60-63, "allows the player to select when the player wants to play and cease playing at the player's sole discretion," column 2, lines 51-52, "player may have the option of identifying himself . . . to initialize the game," column 4, lines 47-49, and "[s]hould the player decide to commence play," column 4, line 67, to column 5, line 1. Again, when Weiss says that the "memory card is updated," it does not appear to be updated with the status of a "paused" game but, rather, with an increment or decrement within a "rewards" program. Column 5, lines 23-43.

The Applicants believe that Weiss's lack of teaching on "pausing" a wagering game is what caused the Examiner to state "[a]lthough Weiss implies allowing players to continue play of the game beginning form a point at which the game was paused, he fails to clearly state it." Final Office Action, page 3. In fact, after a closer reading of Weiss, the Applicants note that Weiss appears to be teaching nothing more than a simple "rewards" program for customer loyalty, like those available from hotels or airlines. After the player receives Weiss's card from the casino, he or she plays wagering games and attempts to obtain "milestones" while playing those wagering games. See column 1, lines 63-67; column 2, lines 7-11; column 2, lines 30-34; Abstract. Once certain milestones are achieved, the player can then go to the redemption center 110 of FIG. 4

which has an output 180 for distributing an award to a player. Column 4, lines 22-26. See also, column 5, lines 27-43. In short, Weiss is unclear and only appears to teach a simple "rewards" program, and not the storage of a "paused" wagering game.

Because the references do not disclose at least one element of the rejected claims, a *prima facie* case of obviousness has not been established.

Other Improper Rejections Based On Walker

Regarding claims 5, 11, 15, 20 and 21, Walker does not teach associating the status of the paused game of chance with a personal identifier of the player. The Office Action states that "Walker teaches storing and retrieving game outcome associated with player identifier." A game outcome does not, however, correspond to a status of a paused game. For example, a game outcome 714 shown in FIG. 6C of Walker is a cherry-cherry-cherry outcome (record 758). A triple-cherry or any other game outcome does not indicate the status of the game being played and, therefore, Walker's disclosure of associating a game outcome with a player identifier has no bearing on the patentability of these claims.

Regarding claims 12 and 15, Walker does not teach "providing personal identifier to the central storage prior to retrieving the status of the paused game, 12:31-48." Final Office Action, page 4. Walker clearly states that the "player identifier, client identifier and outcome are transmitted by client gaming device 300 *after* a play of the machine." Column 12, lines 31-48. Therefore, Walker explicitly teaches away from providing a player identifier at any time prior to play completion.

Conclusion

It is the Applicants' belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,

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